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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/354,080	07/15/1999	MASSIMO BALESTRI	21197	4578

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EXAMINER

KLIMACH, PAULA W

ART UNIT	PAPER NUMBER
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2131

DATE MAILED: 11/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/354,080

Applicant(s)

BALESTRI ET AL.

Examiner

Paula W Klimach

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

This office action is in response to amendment filed on 8/11/03 (Paper No. 7). Original application contained Claims 1-15. Applicant amended Claims 1-4, 6-11, and 13-14. Applicants also have made the appropriate adjustment to Claim 1 to overcome claim objection as identified in previous office action (Paper No. 3). The amendment filed on 8/11/03 have been entered and made of record. Therefore, presently pending claims are 1-15.

Response to Arguments

Applicant's arguments filed 8/11/03 have been fully considered but they are not persuasive because of following reasons.

Applicant argued, "...*Martin's data streams are analog data streams, not digital data streams...*". This is not found persuasive. Spies discloses the transmission of digital data (column 5 lines 25-35). Martin also discloses video signals in general (column 3 line 64 to column 4 line 5). Video signals may be transmitted and encoded in the form of digital data as disclosed by Spies. The digital stream as disclosed by Newton's telecom dictionary is a flow of digital information and a packet is a bundle of data usually in binary form. Streams and packets both refer to digital data.

Applicant further argued, "...*the applicant discloses a system and method for the controlled delivery of digital services, wherein the digital data streams incorporate at least one algorithm not a packet key...*". This is not found persuasive. The packet keys, disclosed by Spie (column 9 lines 52 to column 10 line 8), determine the function that is used for encrypting and decrypting the video packets. As a result, the packet keys determine the security of the data.

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The embedded algorithm of the application determines the security of the data in the application. Since the keys determine the security of the data in Spie and the algorithm determines the security of the data in the application, then embedding the key is the equivalent of embedding the algorithm, since the keys in Spie perform the task of the algorithm in the application.

Applicants clearly have failed to explicitly identify specific claim limitations, which would define a patentable distinction over prior arts.

The examiner is not trying to teach the invention but is merely trying to interpret the claim language in its broadest and reasonable meaning. The examiner will not interpret to read narrowly the claim language to read exactly from the specification, but will interpret the claim language in the broadest reasonable interpretation in view of the specification. Therefore, the examiner asserts that Martin and Spies do teach or suggest the subject matter broadly recited in independent Claims 1 and 8. Dependent Claims 2-7 and 9-15 are also rejected at least by virtue of their dependency on independent claims and by other reason set forth in this office action (Paper No. 3). Accordingly, rejections for claims 1-15 are respectfully maintained.

Claim Rejections - 35 USC § 103

Claim 1, 2, 3, 4, 6, 7, 8, 9, 10, 11, 13, and 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Martin (5, 539, 823) in view of Spies (6, 055, 314).

In reference to claims 1 and 8, Martin discloses a method for the controlled delivery of digital services within a plurality of providers (SP) and users (U), wherein said services are identified by respective stream of encoded video signal (digital data) emitted by said providers (SP) (claim 1 lines 7-12 and line 18 in combination with column 5 lines 20-26) and the users are provided with receiver (STB) to receive said video signal (digital data) streams, the receiver

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being selectively enabled to make use of determined services through a respective user unit (105) (column 11 lines 41-45).

However Martin does not expressly disclose at least one algorithm for enabling the use of respective determined services.

Spies discloses a user unit comprising the steps of: incorporating into said digital data streams at least one algorithm for enabling the use of respective determined services (TMW2), incorporating into said digital data streams a respective identifying code (EMM) for each user (U) to be enabled to receive a certain service, associating to said user unit (105) a processing function (VM) capable of recognizing and exploiting said at least one enabling algorithm by exploiting said identifying code to enable the receiver (STB) of the respective user to make use of said service (column 9 lines 52 to column 10 line 8). Spies also teaches of a key that is transmitted from the merchant computing unit, column 6 lines 21-25. This key is the identifying code because it is used to identify the smart card to which the algorithm is to be downloaded and thus the purchaser.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to use the system described by Spies to incorporate the algorithm for enabling the use of the services into a data stream. One of ordinary skill in the art would have been motivated to do this because building a system that has no global secrets built into any hardware eliminates the risk of cracking the specific hardware component, Spies column 2 lines 0-5.

In reference to claims 2, 3, 9, and 10, the user unit is configured as a removable processing support in the Spies system, 50 in figure 9. The removable processing unit is a smart

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card, abstract. The smart card is associated with the purchaser (user), claim 44 lines 1-4, and arranged to selectively associate said reception means, column 3 lines 5-10.

In reference to claims 4, 6, 11, and 13, the system described by Spie discloses a program key that is download over the network, therefore in a data stream, onto the smart card to enable the viewing of the purchased video, column 16 lines 20-30 and Fig. 9.

In reference to claims 7 and 14, the system described by Spies can be activated by the user unit to transmit information about the confirmation of the purchase request, thus about the delivery of the service.

Claims 4 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin and Spies as applied to claim 8 above, and further in view of Jones et al (5, 623, 637).

Martin and Spies do not expressly disclose a system with a trusted middleware function in the reception means and a trusted middleware function in the dynamic part.

Jones discloses an embodiment of a system where trusted software carries out an authentication algorithm on the IC card (smart card) as well as on the host, column 8 line 13-34.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have a trusted middleware function in the static part (the host in the Jones system) and have a middleware in that dynamic part (the smart card). One of ordinary skill in the art would have been motivated to do this because the removable card allows data stored on the card to be made immediately available to the connected host computer, Jones column 2 lines 23-29.

Claims 5 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin and Spies as applied to claim 1 and 8 respectively above, and further in view of Waslewski (6,157,719).

Martin and Spies do not expressly disclose a system where the service providers emit data streams as MPEG data streams and receivers that extract the EMM messages, interpret the identifying code and execute the enabling algorithm on the basis of the identifying code.

Waslewski teaches of a system for conditional access where the service provider sends data streams in MPEG format, column 18, lines 32-35. The receiver extracts the EMM message from the data stream, column 5 lines 9-13, where it stores the information from the EMM, therefore must extract the information. It uses a control word that includes authorization information from the EMM, therefore it interprets the identification code contained in the EMM message, column 4 lines 52-58. Waslewski teaches of an algorithm that generates the control word, which is used to decrypt the information, if the subscriber is entitled to watch the program, thus an enabling algorithm that is on the basis of the authentication information (identification code).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to use the Waslewski system for sending MPEG data streams from the service provide described by Martin. One of ordinary skill in the art would have been motivated to do this because service providers (service distribution organizations) provides its subscribers with information from a number of services, Waslewski column 4 lines 18-25.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Martin and Spies as applied to claim 8 above, and further in view of Kaplan et al (6,141,339).

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Martin and Spies do not teach the use of Java cards.

Kaplan teaches of Java cards used to receive applets from service nodes, column 5 lines 59-61. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to use Java cards for the user unit. One of ordinary skill in the art would have been motivated to do this because Java applets provide the intelligence to support features, Kaplan column 5 lines 61-65.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

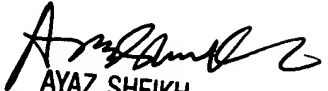
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paula W Klimach whose telephone number is (703) 305-8421. The examiner can normally be reached on Mon to Fri 7:15 a.m to 3:45 p.m.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (703) 305-9648. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4832.

PWK


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